

## **DETAILED ACTION**

This office action is in response to applicant's filing of March 23, 2006.

### ***Status of Claims***

Claims 1-4 are currently pending and are the subject of this office action.

Claims 1-4 are presently under examination.

### ***Priority***

The present application is a 371 of PCT/JP04/25336 filed on 07/15/2004, and claims priority to foreign application: JAPAN 2003-197229 filed on 07/15/2003.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-4 are rejected under 35 U.S.C. 102(b) as being anticipated by Shimizu et. al. (Bioorganic and Medicinal Chemistry Letters (2002) 12:3363-3366, cited by applicant).

Claim 1 recites a therapeutic agent represented by the general formula I, wherein R represents a hydroxyl-protecting group releasable under acidic conditions.

The statement in claim 1: "for hypercalcemia or bone diseases" is considered an intended use and does not add any new limitation to the claim. *Catalina Mktg. Int'l, Inc. V. Coolsavings.com, Inc.*, 289 F.3d 801, 808, 62 USPQ2d 1781, 1785 (fed. Cir. 2002). "The recitation of a new intended use for an old product does not make a claim to that old product patentable." *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997).

For claim 1, Shimizu teaches a compound of formula I, wherein R is tert-butyldimethylsilyl (a well known hydroxyl-protecting group releasable under acidic conditions, see compound 7, page 3365).

Claim 2 recites a reveromycin A derivative of formula I (see claim 1), wherein R is a tert-butyldimethylsilyl group (TBS).

For claim 2, Shimizu teaches a compound of formula I, wherein R is tert-butyldimethylsilyl (see compound 7, page 3365).

Claims 3 and 4 recite a reveromycin A derivative represented by formula II.

The statement in claim 4: "for hypercalcemia or bone diseases" is considered an intended use and does not add any new limitation to the claim. *Catalina Mktg. Int'l, Inc. V. Coolsavings.com, Inc.*, 289 F.3d 801, 808, 62 USPQ2d 1781, 1785 (fed. Cir. 2002). "The recitation of a new intended use for an old product does not make a claim to that old product patentable." *In re Schreiber*, 44 USPQ2d 1429 (Fed. Cir. 1997).

For claims 3 and 4, Shimizu teaches a compound of formula II (see compound 6 on page 3365).

***Conclusion***

No claims are allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MARCOS SZNAIDMAN whose telephone number is (571)270-3498. The examiner can normally be reached on Monday through Thursday 8 AM to 6 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael P. Woodward can be reached on 571 272-8373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/MARCOS SZNAIDMAN/  
Examiner, Art Unit 1611  
April 24, 2008

/MP WOODWARD/  
Supervisory Patent Examiner, Art Unit 1615